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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,442	10/23/2003	Wayne H. Whittaker	UNS-103-B	8021
7590 Todd L. Moore YOUNG & BASILE, P.C. Suite 624 3001 West Big Beaver Road Troy, MI 48084-3107			EXAMINER GILBERT, WILLIAM V	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 07/21/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/692,442

**Applicant(s)**

WHITTAKER ET AL.

**Examiner**

William V. Gilbert

**Art Unit**

3635

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) 4-6 and 10-16 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3, 7-9, 17-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

This is a first action following a request for continued examination. Claims 1-20 and new claims 21-24 are pending. Claims 4-6 and 10-16 are withdrawn from consideration. Claims 1-3, 7-9 and 17-24 are examined.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 April 2008 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 21 and 23** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner does not notice in the specification as filed where the foundation defines a first open end and a second open end as claimed nor the upper and lower portions as "substantially tubular". If applicant obtained these limitations from the drawings, then these must be labeled in the drawings as well and provided proper disclosure without adding new matter.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1-3, 7, 9, 17 and 21-24** are rejected under 35 U.S.C. 102(b) as being anticipated by Christy (U.S. Patent No. 4,074,474).

Claim 1: Christy discloses an apparatus for isolating and leveling a machine foundation with respect to a substructure comprising a rigid enclosure (Fig. 9) having a substantially hollow upper portion (see "A" from attached Fig. 9, below, the spacers show that it is substantially hollow) telescopically adjustably connected to a substantially hollow lower portion ("B" below) to provide for various sizes of the enclosure;, means for rigidly connecting the upper portion of the enclosure to the lower portion ("C" below) for fixing the position of the upper portion with the lower portion and means for providing leveling adjustment ("D" below; the inflatable portion) of the foundation.

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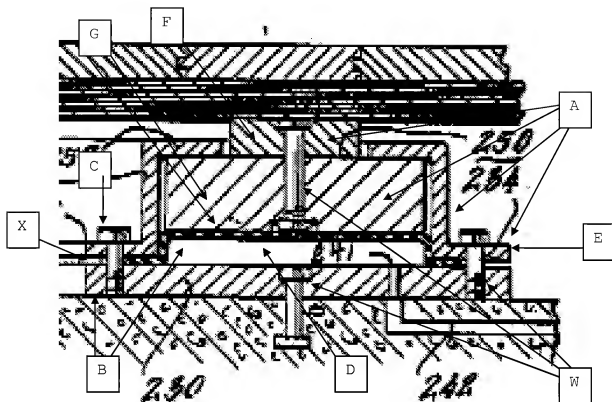


Figure 9 from Christy

Claim 2: the upper portion has a flange ("E" above) having an aperture extending therethrough (the bolt is in the aperture) and the lower portion has an anchor ring (230; see Fig. 9, generally where it is ring-shaped) with at least one rod (the bolt, "C" above) connected thereto and extending through the aperture in the flange above the upper portion, and a slip joint (the connection between the upper and lower sections is a slip joint) connected to the flange of the upper portion for releasably connecting the rod to the flange.

Claim 3: the lower portion has an anchor ring (230; see Fig. 9, generally where as shown this is a ring-shaped device, the upper surface extends into the interior as it is a part of the interior,) a bearing member ("F" above) within the enclosure and adjustable connecting to the anchor ring (via the leveling means) to provide a leveling adjustment of the foundation, and a support member ("G" above, including inflatable portion) in contact with the bearing member and engageable with the substructure. The two members "engage" via the lower portion.

Claim 7: the support member is capable of being removed and is between the bearing member and substructure (12) and the support member can be replaced with other support members.

Claim 9: Christy discloses an apparatus for isolation and leveling comprising a rigid enclosure connectable to the machine foundation having a substantially hollow upper portion ("A" above) and a substantially hollow lower portion ("B" above) telescopically connected to one another, the lower portion having an anchor ring (230) that extends into the interior of the enclosure (the upper surface of the ring extends into the enclosure,) a bearing member ("F" above) disposed within the enclosure above the anchor ring, a plurality of fasteners (see "W" above) that connect the bearing member to the anchor ring in a vertically spaced relationship (see Fig. 9) for vertical

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adjustment of the anchor with the bearing member (the members can be loosened or tightened as needed for adjustment,) and a support member ("G" above and leveling means) in contact with the bearing member and engageable with the substructure for isolating the machine foundation from the substructure.

Claim 17: the support member is capable of being removably disposed between the bearing member and substructure and is replaceable.

Claim 21: the upper portion is tubular (it is in the shape of a ring, which is tubular) and having open ends (there is an open end on each side of the bearing member), the lower portion is substantially tubular (it is in the shape of a ring) and having open ends (see "X" above; the joints between the upper and lower portion on each side is an open end.)

Claim 22: Applicant should respectfully note that the limitation "fabricated" is considered product-by-process; therefore, determination of patentability is based on the product itself. See M.P.E.P. §2133. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re*



*Thorpe*, 777 F.2d 695 (Fed. Cir. 1985). The pieces are integral in that they are attached to each other.

Claim 23: the language "connectable...machine foundation" lines 2-4 is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The open end at a top surface of the foundation would be proximate the bearing member as shown in Fig. 9 and the second open end at a bottom surface of the foundation would be as proximate "X" above and also 241. The applicant should respectfully note that the "machine foundation" is not positively claimed, so it is not considered, but rather only the capability of the prior art of record to perform the function with a foundation as claimed.

Claim 24: the anchor ring has an inner perimeter (proximate "X") and the fasteners ("C" above) are arrayed around the anchor ring adjacent the inner perimeter.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 8 and 18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christy.

Claims 8 and 18: the species of Fig. 9 discloses an inflatable portion (232), but not that it is an air bag, as claimed; however, the species of Fig. 6 discloses the use of an inflatable air bag (containing portion 172.) It would have been

obvious at the time the invention was made to a person having ordinary skill in the art to substitute the inflatable portions because the species are obvious variants of each other and the inflatable element serves the same function in both species and would perform equally as well.

Claim 19: a conduit (242) coupled to and in communication with the inflatable portion (which would be the air bag) and while the particular species in Fig. 9 does not disclose a pressurized air source for communicating pressurized air to and from the bag, the species in Fig. 4 discloses the device (92). It would have been obvious at the time the invention was made to a person having ordinary skill in the art because the inflating system would obviously require a device for inflation and deflation and the apparatus in Fig. 4 would clearly provide such a means for inflation.

Claim 20: a conduit (242) extending through the substructure (12) and into the enclosure where the conduit communicates with the inflatable portion (which would be the airbag.)

***Response to Arguments***

5. The following addresses applicant's remarks/arguments dated 28 April 2008:

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection as applicant amended the claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./  
Examiner, Art Unit 3635  
/Basil Katcheves/  
Primary Examiner, Art Unit 3635